## REMARKS/ARGUMENTS

This paper is submitted in response to the Office Action mailed April 15, 2004. At that time claims 1, 2, 5-22, 24-28 and 30-50 were pending in the application. The Examiner indicated that claim 27 would be allowable if rewritten in independent form. However, the Examiner rejected claims 1, 2, 5-18, and 40-50 under 35 U.S.C. §103(a) as being unpatentable over the article written by Hanning et al. (hereinafter "Hanning") in view of the article written by Beale and Sudmeier (hereinafter "Beale"). Claims 19-22, 24-26, and 30-39 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hanning in view of Beal, and further in view of the article written by Li et al. (hereinafter "Li"). Claim 28 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hanning in view of Beale and Li and further in view of the article written by Kim et al. (hereinafter "Kim"). By this paper, claims 1, 2, 5-22, 24-28 and 30-50 are presented for reconsideration by the Examiner.

The Applicants would like to thank Examiner John S. Starsiak for conducting a telephonic interview on June 17, 2004 with Applicants' attorney Matthew S. Bethards (Reg. No. 51,466). Rejected claims 1, 2, 5-22, 24-28 and 30-50 were discussed, specifically in light of Hanning and Beale. Applicants argued that the Examiner failed to establish *prima facie* obviousness because neither Hanning nor Beale (nor any other cited reference) disclose the limitation of rastering the excitation beam onto the capillary along part or all of the length of the capillary. Examiner agreed that neither reference explicitly discloses this limitation, but maintained that Beale implicitly discloses rastering the excitation beam through the "general teaching" of Beale. Accordingly, an agreement was not reached with the Examiner regarding the patentability of the pending claims.

### REJECTION OF CLAIMS 1, 2, 5-18 AND 40-50 UNDER 35 U.S.C. §103(a)

Claims 1, 2, 5-18 and 40-50 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hanning in view of Beale. *See* Office Action, page 2. Applicants respectfully traverse this rejection.

According to MPEP §2143.03, to establish a *prima facie* case of obviousness, "all of the claim limitations must be taught or suggested by the prior art." (citing *In re Royka*, 490 F.2d 981,

180 USPQ 580 (C.C.P.A. 1974)). Claims 1, 2, 5-18 and 40-50 include the limitation of rastering the excitation beam onto the capillary. This limitation is not taught or disclosed by either Hanning or Beale, and was not addressed in the Office Action. Consequently, the combined teaching of Hanning and Beale does not render these claims *prima facie* obvious under §103(a).

However, as was evident from the telephonic interview the Examiner has taken the position that even though none of the references explicitly teach rastering the excitation beam, the limitation would be obvious to one of ordinary skill in the art based on the general teaching of Beale. Applicants submit that the only possible motivation to combine references and modify them as suggested by the Examiner is hindsight reconstruction using Applicants' disclosure as a blueprint. One "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000) (citations omitted).

One having ordinary skill in the art would not be motivated to modify Beale to raster the excitation beam because the confocal optics system used in Beale does not lend itself to movement. That is why Beale teaches movement of the capillary and not the excitation beam. Furthermore, the combination of Beale and Hanning would not result in the claimed invention. Instead, combining Beale with Hanning would result in an arrangement where the excitation beam remains fixed and the liquid-core waveguide (LCW) assembly moves, which is a system that is not claimed in the present application.

Furthermore, Hanning is not prior art under §102. A declaration under 37 C.F.R. §1.131 has been concurrently filed herewith establishing that the claimed invention was conceived and reduced to practice before the July 6, 2000 internet publication date of Hanning. Since Hanning is not a reference under §102(b) and is not prior art under §102(a), Hanning cannot be used in rejecting the pending claims for obviousness under §103(a). Withdrawal of this rejection is respectfully requested.

**REJECTION OF CLAIMS 19-22, 24-26, AND 30-39 UNDER 35 U.S.C. §103(a)**

Claims 19-22, 24-26, and 30-39 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hanning, in view of Beale and further in view of Li. *See* Office Action, page

4. Applicants respectfully traverse this rejection. Since Hanning is not prior art and, as discussed above, the combined references do not disclose all of the claim limitations, the rejection under 35 U.S.C. §103(a) is improper. Withdrawal of this rejection is respectfully requested.

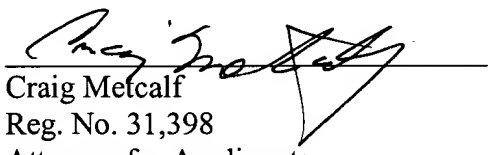
**REJECTION OF CLAIM 28 UNDER 35 U.S.C. §103(a)**

Claim 28 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hanning in view of Beale and Li, and further in view of Kim. *See* Office Action, page 5. Applicants respectfully traverse this rejection. Since Hanning is not prior art and, as discussed above, the combined references do not disclose all of the claim limitations, the rejection under 35 U.S.C. §103(a) is improper. Withdrawal of this rejection is respectfully requested.

**CONCLUSION**

Applicants respectfully assert that claims 1, 2, 5-22, 24-28 and 30-50 are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,



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